

## **REMARKS**

Each paragraph of these Remarks responds to the corresponding paragraph of the Office Action mailed August 11, 2005.

1. Applicant acknowledges that the amendments filed on May 20, 2005 have been entered.

2. Applicant acknowledges that the arguments with respect to claims 18 and 21 in the May 20, 2005 filing have been deemed persuasive, resulting in the allowability of claim 21 and rejection of claim 18 as discussed below.

3. The Applicant respectfully traverses the Examiner's determination in this paragraph that "it would have been obvious to one having ordinary skill in the art to move the print head from the present invention location to the co-mailer because Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose or solves a stated problem."

### **(a) Print Head(s) At Co-Mailer vs. At Bindery**

There appears to be a fundamental misunderstanding as to the reasons for having the "print head(s)" at the co-mailer versus at the bindery.

First, the Examiner states that the "print heads" located at the co-mailer of an embodiment of the present invention are "an obvious matter of design choice" (Office Action, p. 3) that provide merely a "duplication [of the printer at the bindery] for a multiplied effect..." (Office Action, p. 5). The Examiner concludes that this "design choice" in claims 9, 18 and 28 is merely used to achieve faster speeds due to this "multiplied effect." ("two print heads would have a multiplied effect of printing the information on the publications faster than the system having just one print head" (Office Action, p. 5); "Mayer et al. can print the same information on the publication although the printing process may be slower than the one having two print heads" (Office Action, p. 8)). However, the additional print heads are not a matter of design choice or speed. This is due to at least the following reasons:

- The United States Postal Service ("USPS") requires that the mail rate be printed on each mail piece presented for delivery. The present application recognized (see citations to the application below relating to the "advantages" of the multiple print

heads) that to provide maximum flexibility in the selection of publications to co-mail, the assignment of publications for co-mailing should occur after binding at the co-mailer, thereby necessitating printing at the co-mailer. This printing at the co-mailer is therefore not a design choice.

- As explained in the present application, there are benefits to having two print heads at the co-mailer since “publishers that design the publications 1110 have varying requirements of where the identifier information should be placed.” (Application as filed at p. 53, lines 1-4). Since one print head cannot print information on both the top and bottom portions of the covers of the publications, there is a distinct benefit to having two print heads.
- While the Mayer Reference discloses printing address information at the bindery, the Applicant has found no disclosure whatsoever in the Mayer Reference for printing of the mail rate on each publication.

Secondly, the Examiner confuses the teaching of the Mayer Reference by stating that the Mayer Reference teaches a first print head, but not a “second print head.” (Office Action, p. 5). The Mayer Reference does not even teach or suggest a first print head because the “first print head” of the embodiment of the present invention is at the co-mailer, while the Mayer Reference teaches zero print heads at the co-mailer and only one print head at the bindery. The claimed invention teaches two print heads at the co-mailer with the advantages and problems solved discussed above and below (including various orientations of the identifier information).

The Applicant clarifies the distinction between the print heads of the Mayer Reference and the present invention below. Key points to understand throughout this discussion are that the Mayer Reference only has a printer at the bindery, not the co-mailer, and the Mayer Reference nowhere discloses that the mail rate is ever printed on each publication.

**(b) Mayer Reference**

The Mayer Reference (U.S. Patent No. 5,287,976) discloses a printer at the bindery only, not the co-mailer. (Ink jet printer 18 of FIG. 1). The Mayer Reference explains that the ink jet printer 18 is used to “address each of the diverse publications with each of the multiple copies substantially in zip code order.” (Col. 6, lines 35-39). The system of the Mayer Reference then uses “the number of copies for each zip code to maximize postal discount...”. (Col. 11, lines

26-29). However, without a printer at the co-mailer, the Mayer Reference must know the number of copies per zip code at the bindery in order to use “the number of copies for each zip code to maximize postal discount.” (Col. 7, line 67 – Col. 8, line 3. Col. 7, line 67- Col. 8, line 3). It is unknown from the Mayer Reference whether or how the ink jet printer 18 at the bindery knows the mail rate, and if known, how and if it is printed on each publication, based on the “number of copies for each zip code” (Col. 11, lines 26-29) before the publications even go to the co-mailer. Simply put, there is no teaching or suggestion whatsoever of a print head(s) at the co-mailer in the Mayer Reference.

Moreover, the Mayer Reference teaches away from printing mail rates at the co-mailer by teaching that the publications coming off the bindery and going to the co-mailer are “accumulated into co-mailing stacks 40 formed by those copies having a common indicia of the assembled mailing information such as zip code and carrier route.” (Col. 7, line 68 - Col. 8, line 3)(emphasis added). By having the copies in stacks (rather than individual publications conveyed as in the embodiment of the present invention), the Mayer Reference teaches away from allowing each publication to have the mail rate printed on it by the print heads at the co-mailer. This is because the Mayer Reference teaches having the copies in stacks, not individually. The Mayer Reference would have no use for a print head at the co-mailer since the publications are stacked coming off the bindery and therefore a print head would be unable to individually print the mail rate on each publication that is maintained in its stack. As such, the Mayer Reference teaches away from having a print head(s) at the co-mailer and therefore it is not an obvious design choice to move the print head to the co-mailer. Reconsideration of this rejection is therefore respectfully requested on this further basis.

**(c) Embodiment of Present Invention**

In contrast, the embodiment of the present invention claims “print head(s)” at the co-mailer. By having the print head(s) at the co-mailer, the co-mailing system of the present invention has greater flexibility than the Mayer Reference to select the publications for co-mailing after binding. The co-mailer of the present invention prints the mail rate after the bindery at the co-mailer based on the total number of copies of the publications per zip code (or other “identifier information”) for all the publications to be co-mailed and as required by the USPS. This is unlike the Mayer Reference that only prints address information at the bindery.

The advantage is greater flexibility by printing the mail rate at the co-mailer versus the bindery since publications can be added at the co-mailer from other bindery runs and conforming to USPS requirements.

So, for example, in the Mayer Reference, once a publication is assigned to a bindery, a predetermined number of publications are addressed by the ink jet printer and placed in zip code order. (Col. 6, lines 35-39). This is not the case for the present invention, where the publications coming off the bindery in the embodiment of the present invention do not have the mail rate or final order determined until the publications are merged at the co-mailer with other publications that will determine the number of publications sent to a particular zip code (or other mail rate requirement) and thereby determine the postal rate (discount). In fact, the embodiment of the present invention even allows the publications coming off the bindery to be stored indefinitely and then later sent to a co-mailer that can be merged with other stored publications. (Application as filed at page 27, line 18 - page 28, line 8).

In response to the Examiner's position that the "Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose or solves a stated problem," the Applicant sets forth the following advantages, particular purposes or problems solved, all disclosed in the present application as filed:

- "The mail rate is determined (FIG. 9 below) and printed on the publication at the co-mailer since the volume discount will not be known until the plurality of diverse publications are received at the co-mailer." (Application as filed at page 25, lines 7-10).
- "In fact, it is another benefit of the system of the present invention that the different publications may be stacked and maintained in their unique order for extended periods of time and yet be later moved to the co-mailer to be combined with many other diverse publications...". (Application as filed at page 28, lines 2 - 7).
- "Furthermore, at this stage [at the bindery], no mail rate has been determined since the mail rate will be determined at the co-mailer where more of a volume discount may be taken advantage of." (Application as filed at page 41, lines 15 - 18).

- “The MR [mail rate] is determined after all the verified sequence lists have been merged into the merged verified sequence list 805 (FIG. 8) which provides a significant benefit. This benefit is the volume discount that may now be determined. That is, now that the many verified sequence lists have been merged, the MR may be determined tak[ing] advantage of large volume discounts.” (Application as filed at page 51, lines 6 – 12).

These portions of the present application provide instances of the advantages of having the print head at the co-mailer, i.e. providing greater volume postal discounts. Accordingly, the Applicant submits that the Applicant has disclosed an “advantage”, “particular purpose” or “stated problem” solved by the bulleted items above.

Allowance is therefore requested for all claims setting forth the “print head(s)” limitation, namely claims 9, 18 and 28.

4. The Applicant acknowledges that the text of the relevant U.S. Code sections are found in prior Office Actions.

5. The Examiner has rejected claims 9, 18 and 28 under 35 U.S.C. §103 as unpatentable over the Mayer Reference. With regard to claims 9, 18 and 28, each of these claims calls for a first and second “print head” at the co-mailer, which the Mayer Reference does not teach or suggest as explained in detail in paragraph 3 above. Accordingly, the Applicant respectfully traverses the Examiner’s rejection for all the reasons set forth in paragraph 3 herein. For those reasons, allowance of claims 9, 18 and 28 is respectfully requested.

6. The Examiner rejected claim 13 under 35 U.S.C. §103 as being unpatentable over the Mayer Reference in view of the Delfer Reference (U.S. Patent No. 5,264,665).

Claim 13 calls for, among other things, a “system for combined mailing...comprising...a bindery...further comprising...a thickness measurement device...and...a weight measurement device...”. The Examiner stated that the Mayer References shows all the elements of claim 13 except for the “thickness measurement device and scale.” (Office Action, p. 11). To make a *prima facie* case of obviousness, the Examiner must meet three criteria as explained in M.P.E.P. §2143:

### 2143 Basic Requirements of a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

M.P.E.P. §2143.

#### (a) No Suggestion Or Motivation To Combine References

Here, the first criteria has not been met by the Examiner, namely to show a suggestion or motivation to combine the Mayer and Delfer References. The initial burden is on the Examiner to show the suggestion or motivation to combine the references:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*,

M.P.E.P. §2142. The Examiner's sole basis for the obviousness rejection was the "knowledge which was within the level of ordinary skill at time the claimed invention was made...":

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure,

such a reconstruction is proper. See *In re McLaughlin*, 443 F.3d 1392, 170 USPQ 209 (CCPA 1971).

(Office Action, pp. 3-4). Such a basis, however, without providing a more “convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references”, as explained in *Ex Parte Clapp* above, is clearly improper as explained in the following section of the M.P.E.P:

**IV. < FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS**

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed inven-

tion were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obvious-

M.P.E.P. § 2143.01. Thus, the Examiner’s rejection relying solely only on the knowledge of ordinary skill in the art is improper. (M.P.E.P. § 2143.01 at p. 2100-129 (Rev. 2, May 2004)) (“The level of ordinary skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)”). A more “objective reason” is required and Applicant respectfully requests that the Examiner reconsider that rejection on that basis.

Although the Examiner has not satisfied his initial burden of coming forward with evidence of the motivation or suggestion to combine these references, the Applicant submits that there is no such suggestion or motivation to combine for the simple reason that the Delfer Reference does not teach publication weight and thickness measurement integrated in a bindery and co-mailing system. Such integration requires “size restrictions...up to a maximum height, length and thickness, or even a maximum weight” in order to work in the bindery/co-mailer

system that does not exist in the teachings of the Delfer Reference. (Application as filed at 20, lines 5-8). The Delfer Reference merely discloses a weight and thickness measurement computer system for envelopes to optimize direct mailing costs, having none of these bindery/co-mailing restrictions. Should the Examiner maintain this rejection, the Applicant respectfully requests that a *prima facie* showing of obviousness be provided under M.P.E.P. §2143 as discussed above.

7. The Examiner rejected claims 14-15 under 35 U.S.C. §103 as being unpatentable over the Mayer Reference in view of the Humes Reference (U.S. Patent No. 5,377,120).

(a) **Claim 14**

Claim 14 calls for a co-mailing system comprising, among other things, a “co-mailer merge and sequence module.” The Examiner admits that the “co-mailer merge and sequence module” is not found in the Mayer Reference, but combines the Mayer Reference with the Humes Reference to make the §103 rejection. However, as discussed above in paragraph 6 (incorporated in this paragraph by reference), the Examiner has not fulfilled his initial burden of showing the *motivation or suggestion* to combine these two references. M.P.E.P §§2142 and 2143 set forth a clear initial burden on the Examiner to show this motivation or suggestion to combine these references, and the Applicant respectfully requests the Examiner to meet his initial burden.

(b) **Claim 15**

Claim 15 calls for a co-mailer system having, also among other things, a “co-mailer control module.” The Examiner rejected claim 15, along with claim 14, on the sole basis that the Mayer Reference disclosed all elements except for the “co-mailer merge and sequence module,” and that element was disclosed in the Humes Reference. However, the Examiner has made no showing whatsoever as to where the “co-mailer control module”, different than the “co-mailer merge and sequence module,” is shown in either the Mayer or Humes Reference. As discussed above in paragraph 6 (incorporated herein by reference), the Examiner must show both (i) the *motivation and suggestion* to combine the two reference and (ii) that the prior art references



“show all the limitations.” M.P.E.P. §2143. The Examiner has done neither with regard to this claim 15 and therefore allowance is respectfully requested.

8. The Applicant acknowledges the allowance of claims 21-23.

### **CONCLUSION**

For the reasons provided above, allowance of all pending claims is respectfully requested.

A Petition for One Month Extension of Time is filed concurrently herewith, along with a check to cover the filing fee. If any additional fees are in fact due, please charge any amount due (or credit any overpayment) to Deposit Account No. 13-0019.

Respectfully submitted,



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